

Serial No. 10/766,122
Filed: January 27, 2004

REMARKS

With entry of the present amendment claims 4, 11, 12, and 28 to 30 are pending. Claims 1 to 3, 5 to 10, and 13 to 27 have been cancelled without prejudice or disclaimer. Claims 4, 11, 12, and 28 to 30 have been amended to place claim 11 in independent form, to correct typographical errors, and to clarify the term "modification." The amended claims are supported by the specification and claims as originally filed. No new matter has been added by these amendments.

No additional fees are believed due. However, the Director is hereby authorized to charge any deficit, or credit any overpayment, to Deposit Account No. 08-2525.

OBJECTIONS TO CLAIMS 2 TO 6, 9 TO 11, 13, 15, AND 28 TO 30

Claims 2 to 6, 9 to 11, 13, and 15 have been objected to as duplicates of claim 1. In making this rejection, the Office Action states that each of the claims describes the same crystalline compound using different language. Applicants have retained compound claim 4 and composition claims 11 and 12. All other compound and composition claims have been cancelled rendering this objection moot.

Claim 2 stands objected to with regard to specific claim language. This claim has been cancelled with regard to the duplicate claim objection discussed above rendering this objection moot.

Claims 28 to 30 have been objected to on the basis that the notation " $1\lambda^6$ " is missing in certain instances from the compound name. These claims have been amended to insert the missing notation. The omission is an obvious typographical error and addition of " $1\lambda^6$ " does not alter the scope of the claims. For this reason, Applicants respectfully request reconsideration and withdrawal of this objection.

REJECTION OF CLAIMS 1 TO 15 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1 to 15 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. In making this rejection the Office Action alleges that the term “crystalline modification” is unclear in that it implies a process. In accordance with the examiner’s suggestion, applicants have amended the claims to recite a “crystalline form.”

While applicants respectfully disagree that one having ordinary skill in the art would not understand the meaning of “crystalline modification,” the terms “form” and “modification” are interchangeable and each simply indicates that the 2-(3,5-bis-trifluoromethyl-phenyl)-N-[6-(1,1-dioxo-1λ⁶-thiomorpholin-4-yl)-4-(4-fluoro-2-methyl-phenyl)-pyridin-3-yl]-N-methyl-isobutyramide of the claims has a new and different crystalline structure from that previously described by applicants in copending application 10/067,996. This amendment does not alter the scope of the claims.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

COMMENTS REGARDING METHOD OF USE CLAIMS 16 TO 27

The Office Action indicates that rejoinder of claims 16 to 27 would raise double patenting issues and issues under 35 U.S.C. § 112, first paragraph. However, the claims have not been rejoined and no actual rejection has been made. Applicants submit that such comments with regard to claims that are withdrawn and not under examination are improper. Applicants further submit that even if such issues were to exist, as alleged by the examiner, they would not be a proper basis for denying rejoinder of the claims. Claims 16 to 27 have been cancelled in response to the restriction requirement without prejudice or disclaimer to the filing of a divisional application. The claims have not been cancelled in regard to the miscellaneous comments in the Office Action

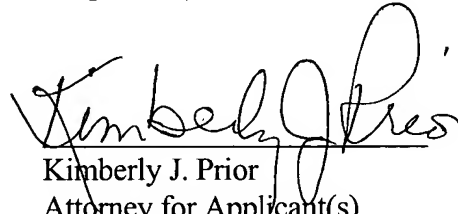
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and have not been cancelled for reasons of patentability as no examination or rejection was made with regard to these claims.

The foregoing amendment is fully responsive to the Office Action issued September 2, 2005. Applicants submit that Claims 4, 11, 12, and 28 to 30 are allowable. Early and favorable consideration is earnestly solicited.

If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kimberly J. Prior", is written over a horizontal line.

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